

REMARKS

Claims 28-37 are pending in the present application. Claim 29 was amended in this response. No new matter has been introduced as a result of the amendments.

Claim 29 was rejected under 35 U.S.C. §112, first paragraph, for failing to comply with the enablement requirement. Applicants traverse this rejection. Before any analysis of enablement can occur, it is necessary for the examiner to construe the claims. In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure). A specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. (MPEP 2164.04). In light of the present amendment to claim 29, Applicants submit the rejection has been overcome. Withdrawal of the rejection is respectfully requested.

Claims 28, 30-32, 36 and 37 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Su et al.* (US Patent 6,693,898) in view of the admitted prior art. Claims 33-35 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Su et al.* (US Patent 6,693,898) in view of the admitted prior art and further in view of *Giordano II et al.* (US Patent 6,285,364). Applicant traverses these rejections. Favorable reconsideration is respectfully requested.

Specifically, the cited art, alone or in combination, does not disclose “an interface unit for operatively coupling the terminal device to the packet-switched communication network wherein the first signaling information is transmitted between the communication network and the data processing device through the interface with the assistance of signaling packets of the packet-switched communication network, and the second signaling information is transmitted between the communication network and the data processing device through the interface with the assistance of data packets of the packet-switched communication network” as recited in claim 28, and similarly in claim 37.

Regarding *Su*, the reference teaches a packet-based intelligent telecommunications network that implements the Bellcore GR-1129 circuit-switched call control model (see Abstract; claim 1) *within the telecommunication network* (i.e., not in the terminal device). This configuration allows a packet-based intelligent telecommunications network to retain the call control model of the circuit-switched Bellcore GR-1129 standard, while implementing standard packet network protocols. According to *Su*, messaging is exchanged between the Service Control Point and Service Node/intelligent Peripheral (SN/IP) through the Service Switching Point, as in the GR-1129 model, while messaging between the network Service Switching Point and the Service Control Point may occur according to standards and protocols common to circuit-switched networks, such as SS7 or TCP/IP (col. 2, line 66 – col. 3, line 8).

The interface between the Service Switching Point and SN/IP is packet-based, such as H.323, rather than that specified by the GR-1129 standard, where commands provided for by the GR-1129 standard are embedded within the packet-based messaging between the Service Switching Point and SN/IP (col. 3, lines 8-16; col. 4, lines 23-27). *Su* teaches that the above configuration is necessary to provide backward-compatible transmission that does not necessitate the use of TCAP interfaces that directly connect a packet-based SCP and SN/IP such as those found in networks utilizing the SR-3511 standard (col. 2, lines 19-49; col. 4, lines 53-56). This passage only addresses the node processing of GR-1129 using signaling packets of the packet switched network, and explicitly disparages SR-3511 signaling using packet-switched transmissions (col. 4, lines 26-28). The simultaneous transmission and processing of both bits of signaling information is only provided for in the interface between the packet-oriented protocol and circuit-oriented protocol, known as SSP 40. This configuration merely provides that both protocols are capable of being supported in the network, and is not applicable to a particular terminal, which may be configured under one protocol type or another.

This is the problem being discussed in the Background section of the present application: while networks may be configured to support both protocols, the capabilities of the terminal devices are limited to one protocol. In the present claims, the second signaling information is also transmitted up to the terminal devices of the packet-switched communications network. Thus, the terminal itself must support the packet-switched and circuit-switched protocols. In contrast, the terminal 10 described in *Su* is explicitly disclosed as only a packet telephone 10

(col. 4, lines 2-3). Accordingly, the terminal in Su only processes signaling information that is configured to a packet-switching standard and is transmitted via packets of a packet-switching standard. Accordingly, there is no teaching in the reference that allows the terminal to process any sort of circuit-switched signaling information as required in claims 28 and 37. Also, as the Office Action properly noted, Su does not disclose the terminal device containing data processing along with the interface unit. However, the Office Action then goes further to mistakenly rely on the Background section of the present application to claim that the cited passages teach a terminal device enabled with the aforementioned features. As explained above, the Background describes the network capabilities for transmitting information from terminals, either by circuit-switched or packet-switched protocols (the passage from page 3, line 25 to page 4, line 9 merely describes CENTREX communication from either a packet communication or voice communication). The cited section certainly does not disclose first signaling information is transmitted between the communication network and the data processing device *of the terminal device* through the interface with the assistance of signaling packets of the packet-switched communication network, and the second signaling information is transmitted between the communication network and the data processing device *of the terminal device* through the interface with the assistance of data packets of the packet-switched communication network.

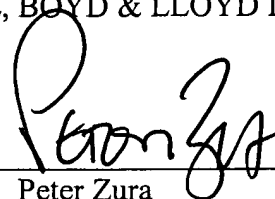
In addition to the deficiencies of the cited text, Applicants maintain that there is no teaching, suggestion or motivation to combine the references in the manner suggested in the Office Action

In light of the above arguments, Applicant submits that the present claims are allowable over the prior art. Applicant also requests that a timely Notice of Allowance be issued in this case. Should there be any additional charges regarding this application, the Examiner is hereby authorized to charge Deposit Account 02-1818 for any insufficiency of payment.

Respectfully submitted,

BELL, BOYD & LLOYD LLC

BY

A handwritten signature in black ink, appearing to read "Peter Zura", written over a horizontal line.

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